

REMARKS

A. 35 U.S.C. § 103

1. Borghesi et al., McLauchlin et al. and Murcko, Jr.

a. Claims 1-3, 8, 9, 11-14, 43, 45-52 and 55

In the Office Action mailed on July 13, 2005, claims 1-3, 8, 9, 11-14, 43, 45-52 and 55 were rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection for exactly the same reasons as presented in Applicants' Amendment filed on January 6, 2005, the entire contents of which is incorporated herein by reference. In the January 6, 2005 Amendment, Applicants pointed out many instances where the rejections presented in the Office Action of October 6, 2004 were improper for various reasons, such as 1) failing to state specific passages of references to support the rejection and 2) misapplying the teachings of references.

In response to Applicants' arguments made in the January 6, 2005 Amendment, the Office Action of July 13, 2005 was mailed. Comparing the rejections under 35 U.S.C. § 103 made in the Office Actions of October 6, 2004 and July 13, 2005 reveals that the Examiner's arguments are exactly the same. In other words, the Examiner has not responded to any of Applicants' arguments made in Applicants' January 6, 2005 Amendment. This is contrary to 37 C.F.R. § 1.104 which states in part:

(a) *Examiner's action.*

* * *

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any

objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

* * *

(c) Rejection of claims.

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(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis supplied)

The above rule is quite clear that a rejection must be given in enough detail so that the Applicant can judge the merit of the rejection. Obviously, a rejection that does not respond to previous arguments made by the Applicant cannot be helpful to the Applicant in judging the merits of the rejection.

The Manual of Patent Examining Procedure (MPEP) also directs Examiners to respond fully to Applicants' arguments. In particular, MPEP § 707.07(f) states in part:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

* * *

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. (emphasis supplied)

The above passage specifically directs an Examiner to “answer the substance” of Applicant’s argument. That passage has improperly been ignored in this case.

In summary, the Patent Rules and the MPEP are quite clear that an Examiner must respond to each of the arguments presented in an Applicant’s Amendment/Response. In the present case, that has not occurred. Accordingly, the Office Action of July 13, 2005 is improper. Furthermore, the fact that the Examiner has failed to respond to Applicants’ arguments should be deemed as evidence that the rejections are improper and should be withdrawn for at least the same reasons given in Applicants’ Amendment filed on January 6, 2005.

b. Claims 15-17, 20-23, 25-28 and 53

Claims 15-17, 20-23, 25-28 and 53 were rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection for exactly the same reasons as presented in Applicants’ Amendment filed on January 6, 2005. As pointed out above in Section A.1.a, Applicants January 6, 2005 Amendment pointed out many instances where the rejections presented in the Office Action of October 6, 2004 were improper. Since the Office Action of July 13, 2005 failed to respond to any of Applicants’ arguments, the Office Action is improper. Furthermore, the fact that the Examiner has failed to respond to Applicants’ arguments should be deemed as evidence that the rejections are improper and should be withdrawn for at least the same reasons given in Applicants’ Amendment filed on January 6, 2005.

c. Claims 29-31, 34-37, 39-42 and 54

Claims 29-31, 34-37, 39-42 and 54 were rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection for exactly the same reasons as presented in Applicants' Amendment filed on January 6, 2005. As pointed out above in Section A.1.a, Applicants January 6, 2005 Amendment pointed out many instances where the rejections presented in the Office Action of October 6, 2004 were improper. Since the Office Action of July 13, 2005 failed to respond to any of Applicants' arguments, the Office Action is improper. Furthermore, the fact that the Examiner has failed to respond to Applicants' arguments should be deemed as evidence that the rejections are improper and should be withdrawn for at least the same reasons given in Applicants' Amendment filed on January 6, 2005.

d. Claim 44

Claim 44 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al. and Murcko, Jr. Applicants traverse the rejection for exactly the same reasons as presented in Applicants' Amendment filed on January 6, 2005. As pointed out above in Section A.1.a, Applicants January 6, 2005 Amendment pointed out many instances where the rejections presented in the Office Action of October 6, 2004 were improper. Since the Office Action of July 13, 2005 failed to respond to any of Applicants' arguments, the Office Action is improper. Furthermore, the fact that the Examiner has failed to respond to Applicants' arguments should be deemed as evidence that the rejections are improper and

should be withdrawn for at least the same reasons given in Applicants' Amendment filed on January 6, 2005.

**2. Borghesi et al., McLauchlin et al.,
 Murcko, Jr. and DiRienzo et al.**

a. Claim 10

Claim 10 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 10 depends indirectly on claim 1. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 1, 2) both access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claim. Accordingly, the rejection is improper and should be withdrawn.

b. Claim 24

Claim 24 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 24 depends indirectly on claim 15. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 15, 2) access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list

of authorized vendors to fulfill an insurance claim. Accordingly, the rejection is improper and should be withdrawn.

c. Claim 38

Claim 38 was rejected under 35 U.S.C. § 103 as being obvious in view of Borghesi et al., McLauchlin et al., Murcko, Jr. and DiRienzo et al. Claim 38 depends indirectly on claim 29. DiRienzo et al. does not cure the deficiencies of Borghesi et al., McLauchlin et al. and Murcko, Jr. since it does not suggest altering Borghesi et al. to either 1) access or display a database of excluded vendors as recited in claim 29, 2) access a database of authorized vendors to fulfill an insurance related claim and display a list of authorized vendors that correspond with the at least on line item or 3) receive a selection of at least vendor from a list of authorized vendors to fulfill an insurance claims. Accordingly, the rejection is improper and should be withdrawn.

B. Claims 5, 19 and 33


Applicants note with appreciation that claims 5, 19 and 53 contain allowable subject matter.

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-3, 5-17, 19-31 and 33-55 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the

next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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